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10/541,469

03/21/2006

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EXAMINER

OU, JING RUI

ART UNIT

PAPER NUMBER

3773

MAIL DATE

DELIVERY MODE

06/21/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/541,469 | Applicant(s) OGAWA ET AL. | |
| | Examiner JING OU | Art Unit 3773 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-12 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11, and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment and RCE filed on 05/20/2010. Claims 1-5 and 8-12 are pending. Claims 1 and 11 are independent. Claims 6 and 7 have been cancelled. Claims 8-10 are withdrawn.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/20/2010 has been entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, 5, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogawa et al (US Pat. No.: 5,846,210).

In regard to Claims 1, 2, 4, 5, 11, and 12, Ogawa et al discloses an medical coil comprising a coil main body (implanted device, 16, Fig. 1) having flexibility and an stretch suppressing member (joint member 15, Figs 1 and 2) which is provided on only

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the inner periphery of the coil main body and which is made of a polyvinyl alcohol polymer (Col. 6, lines 45-49); wherein the stretch suppressing member has a smaller diameter than the coil diameter of the coil main body (Fig. 2), and the stretch suppressing member enters space between adjacent wire turns (the space indicated by L, Figs. 1-3); wherein the coil main body has space between each turn before swelling (Figs. 1-3, every turns adjacent each joint member 15 has space in between); wherein the stretch suppressing member has a rod-like shape (Col. 7, lines 1-3) and is provided in the coil main body so as to pass through the coil main body and extend in the coil axial direction of the coil main body (Figs. 1 and 2); and the diameter of the stretch suppressing member is smaller than the inner diameter of the coil main body by about 1 to 50% in a dry state (Col. 7, lines 9-14 and 22-27 and Fig. 2); wherein the coil main body has space between turns before swelling (Figs. 1 and 2)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa et al (US Pat. No.: 5,846,210).

In regard to Claim 3, Ogawa et al discloses all the limitations of the claim as taught above and further discloses the wire constituting the coil main body has a diameter of 0.07 mm, and the coil main body has a coil diameter of 0.1 mm. Ogawa et al does not appear to disclose a coil length of 2 to 500 mm and a number of turns of 1 to 100 per unit length (1mm).

However, applicant should be noted that the coil length and the number of turns are only design choices and within of one of ordinary skill in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a coil length of 2 to 500 mm and a number of turns of 1 to 100 per unit length (1mm), since it has been held that that where the general conditions of a claim are

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disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

9. Applicant's arguments filed 05/20/2010 have been fully considered but they are not persuasive. The allegation on pages 9-11 of the remarks that the joint member 15 in Ogawa et al is not a stretch suppressing member is incorrect. The joint member 15 in Ogawa et al certainly suppresses a stretch between the wire turns to a certain degree because it provide a compression force to multiple wire turns as a small tensile force is applied to the wire turns (Fig. 2). Therefore, the joint member 15 can be considered as a stretch suppressing member. Applicant should be noted that it is not necessary to the joint member 15 to prevent and suppress an unlimited stretch of the implant device 16. In addition, the stretch suppressing member 15 of the current application would not be able to prevent and suppress an unlimited stretch of the device 10.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JING OU whose telephone number is (571)270-5036. The examiner can normally be reached on M-F 7:30am - 5:00pm, Alternative Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Uyen (Jackie) T Ho can be reached on (571)272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. O./

Examiner, Art Unit 3773

06/12/2010

/(Jackie) Tan-Uyen T. Ho/

Supervisory Patent Examiner, Art Unit 3773